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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,543	12/01/2000	David Yach	555255012129	4943

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EXAMINER
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STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/728,543

Applicant(s)

YACH, DAVID

Examiner

Aaron Strange

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14-20, 22-25, 27-29 and 31-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-20, 22-25, 27-29 and 31-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11262004, 01052005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Cancellation of claims 13,21,26, and 30 is noted. Claims 1-12, 14-20, 22-25, 27-29, and 31-43 remain pending.

### ***Response to Amendment***

2. The declarations filed on 1/5/2005 under 37 CFR 1.131 has been considered but are ineffective to overcome the Lowery reference (US 6,446,111).

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Lowery reference (6/18/1999) to either a constructive reduction to practice or an actual reduction to practice preceding the filing of US provisional application 60/169,032 on December 3, 1999.

4. With regard to the document submitted on tab B, titled "VMLite.cpp Revision History", the periods of time between versions 1.1 and 1.2 (6/23/99 to 8/03/99), 1.7 and 1.8 (8/26/99 to 9/24/99), and 1.13 and 1.14 (10/8/99 to 11/08/99) have not been accounted for. No explanation is given regarding why the software was not worked on during these periods or what work, if any, was being done on the invention during these periods. These three time periods account for more than half of the time period in which diligence must be shown. Applicant's statement "Additional versions of the program interpreter (23 in all) were checked into the revision control system in August, September, October, November, and December of 1999, clearly establishing that we

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were diligently working on this part of the claimed invention during the time period at issue" (Declaration of David Yach, Page 4) is not sufficient since it amounts to a mere pleading rather than a showing of the facts. See MPEP 2138.06.

5. An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959).

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

7. Claims 1-4,10-12,14-20,22,27,28,32-34,36-38,40,42, and 43 rejected under 35 U.S.C. 102(e) as being anticipated by Lowery (US 6,446,111).

The rejections under 102(e) over Lowery, presented in the final Office action of 7/1/04, are maintained.

8. Claims 1-12, 14-20,22, 27,28,31,32,35-39,42, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al. (US 6,473,609).

9. With regard to claim 1, Schwartz discloses a system for retrieving information from one or more information sources, wherein the information includes a plurality of content types, comprising: a host device (link server) (Col 5, Lines 48-61 and Fig 1, 114) coupled to the one or more information sources (network server) (Col 5, Lines 23-35) for retrieving the information; and a translation component coupled to the host device (Col 5, Lines 57-61), the translation component including a plurality of content translators, wherein each content translator is configured to translate one of the plurality of content types into common virtual machine language programs (content is converted into SSD screen commands) (Col 9, Lines 29-49).

10. With regard to claim 2, Schwartz further discloses a plurality of client devices coupled to the translation component, each of the client devices including an interface for receiving common virtual machine language programs from the translation component and a virtual machine engine for executing the received common virtual

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machine language program (programs are received and executed by the mobile device) (Col 9, Lines 29-49).

11. With regard to claim 3, Schwartz further discloses that the plurality of client devices further include a file explorer component for sending an information request to the host device, which then retrieves the requested information from the one or more information sources and passes the requested information to the translation component (file is requested by mobile devices and converted by the link server) (Col 9, Lines 1-5).

12. With regard to claims 4-9, Schwartz further discloses that the content translators include translators for HTML, HDML, WML, and XML (Col 8, Lines 62-67).

13. With regard to claim 10, Schwartz further discloses that the information is retrieved from the one or more information sources through a TCP/IP network connection between the host system and the one or more information sources (landnet that connects link server with the information sources uses HTTP) (Col 7, Lines 15-16 and Fig 1).

14. With regard to claim 11, Schwartz further discloses that at least one of the one or more information sources is a web site accessible via the Internet (landnet may be the Internet) (Col 5, Lines 11-13).

15. With regard to claim 12, Schwartz further discloses a byte code generator coupled to the translation component for compressing the common virtual machine language programs since byte codes are generated (Col 9, Lines 39-47).

16. With regard to claim 14, Schwartz further discloses a network coupling the plurality of client devices to the translation component (airnet)(Fig 1, 102).

17. With regard to claim 15, Schwartz further discloses that the translation component further includes a network protocol interface for transmitting and receiving data via the network (Col 7, Lines 9-13).

18. With regard to claim 16, Schwartz further discloses that the network protocol interface packetizes the virtual machine language programs for transmission to the plurality of client devices via the network (Airnet uses HDTP/UDP and UDP packetizes data) (Col 7, Lines 22-24).

19. With regard to claim 17, Schwartz further discloses that the network (airnet) is a wireless digital data network (Col 5, Lines 26-32).

20. With regard to claim 18, Schwartz further discloses that the wireless digital data network is a packet data network (Airnet uses HDTP/UDP and UDP packetizes data) (Col 7, Lines 22-24).

21. With regard to claim 19, Schwartz further discloses that the plurality of client devices are mobile computing apparatuses (Col 5, Lines 27-32).

22. With regard to claim 20, Schwartz further discloses that the mobile computing apparatuses are PDAs, cellular telephones, Internet appliances, or two-way pagers (Col 5, Lines 27-32).

23. With regard to claim 22, Schwartz further discloses that the content translator is located at the host system (link server) (Col 9, Lines 31-36 and Fig 3, 318).

24. Claims 27,28,31,32,35-39,42, and 43 are rejected for the same reasons as claims 1-22, since they include similar concepts and limitations.

25. Claims 1-12, 14-20, 22-25, 27-29, and 31-43 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

26. With regard to claims 1-12, 14-20, 22-25, 27-29, and 31-43, the document submitted on Tab B of the Declaration of Prior Invention, titled "VMLite.cpp Revision History" along with the Declaration of David Yach provide evidence that the named inventor is not the sole inventor of the claimed subject matter.



In section 2 of the Declaration of David Yach, lines 5-7 state "Attached at Tab B is a listing of changes that were made, some by myself, others by co-workers that were working with me, on a program called VMLite.cpp."

The document titled "VMLite.cpp Revision History" is described in the Declaration of David Yach with the statement "Any time that a software developer made a change to the program under control of this system, a new history entry would be stored, and the changes to the program would also be tracked. This document lists "gbentz" as the author of the program in all of the entries from 11/11/1999 to 12/9/99.

Based on Applicant's own statements, one or more co-workers, including at least the co-worker identified by "gbentz", made changes to the program "VMLite.cpp", which is the "program interpreter" as appears in the claims. In the absence of any evidence to the contrary, any person making changes to the claimed invention must be presumed to be an inventor.

### ***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 5-9, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery (US 6,446,111) in view of Mercer (US 6,547,830).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery (US 6,446,111).

Claims 25,29,35, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery (US 6,446,111) in view of McGarvey (US 5,926,631).

29. The rejections under 103(a) over Lowery, taken alone or in combination with Mercer or McGarvey, presented in the final Office action of 7/1/04, are maintained.

30. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al. (US 6,473,609).

31. With regard to claim 23, while the system disclosed by Schwartz shows substantial features of the claimed invention (discussed above), including that the content translator is coupled to the host system (Col 8, Lines 55-58 and Fig 3), it fails to specifically disclose that the content translator is coupled to the host system using an HTTP interface.

Schwartz discloses the use of an HTTP interface to receive information from the information sources (Col 7, Lines 15-16). While Schwarz remains silent on the interface between the host and the translator, it would have been advantageous to use an HTTP interface since the content being received from the information sources is received via HTTP and it would not need conversion before being sent to the translator.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an HTTP interface to couple the host system to the content translator since the host system already received the data via an HTTP interface and it would not need conversion before being sent to the translator.

32. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al. (US 6,473,609 in view of Doyle et al.

33. With regard to claims 24 and 25, while the system disclosed by Schwartz shows substantial features of the claimed invention (discussed above), including a program store (history) for storing a plurality of virtual machine language programs received from the translation component, determining whether requested information is associated with a program stored in the program store, retrieving the program from the program store if it is located there, and requesting the data if it is not present (Schwartz, Col 16, Lines 21-29). However, Schwartz discloses that these functions are located on the sever rather than the client device.

Doyle teaches that the offloading of processing from a server as a means to reduce both the load on the server and congestion in the network near the server is well known (Doyle, Page 6, Paragraph 1). Since each user of the system disclosed by Schwartz has an individual mobile device, the amount of processing required for the server to convert every request into a virtual machine language program would get very large as the number of users grew. With a sufficiently large number of users, the server

may have become overloaded and unusable (Doyle, Page 5, Paragraph 1). This would have required very expensive server upgrades to keep up with demand (Doyle, Page 6, Paragraph 4). By maintaining a program store and history on the client, the number of requests would be greatly reduced since users often request information they recently looked at. This would greatly reduce the load on the server, improving the speed and reliability of the system for the users and reducing the cost for the service provider.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to maintaining a program store and history on the client since it would have reduced the number of requests made by clients, improving the speed and reliability of the system for the users and reducing the cost for the service provider.

34. Claims 29,33,34,40, and 41 are rejected for the same reasons cited for claims 24 and 25, since they include similar concepts and limitations.

### ***Conclusion***

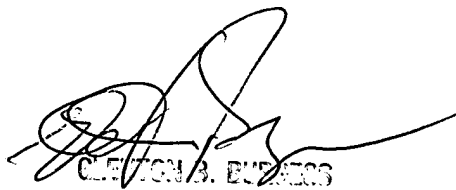
35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS 3/1/2005



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